

**REMARKS**

Applicant affirms the previous oral provisional election of "process" invention I to which original claims 1-7 were drawn, and to which new claims 15-21 are now drawn. Applicant expressly reserves the right to file a divisional application to prosecute claims (presently claims 8-14) directed to the non-elected "apparatus" invention II.

Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, insofar as this rejection may be applied to the new claims 15-21 which have been drafted specifically to overcome each and every one of the Examiner's stated grounds in support of this rejection.

Applicant respectfully **traverses** the rejection under 35 U.S.C. § 102(b) based on anticipation by Brown '220, the rejection under 35 U.S.C. § 103(a) based on unpatentability (obviousness) over Vijuk '931 in view of Brown, and the rejection under 35 U.S.C. § 103(a) based on unpatentability (obviousness) over Vijuk '931 in view of Brown and further in view of Vijuk '195, insofar as these rejections may be applied to the new claims 15-21.

A rejection based on anticipation requires that the applied reference teach, either expressly or inherently, each limitation of each rejected claim, or in other words, that each rejected claim be readable on the reference. As will be evident from the following discussion, clearly such as **not** the case here with respect to the new claims 15-21.

A rejection based on unpatentability requires that the combined teachings of the applied references render *prima facie* obvious the subject matter of each rejected claim. Again, Applicant respectfully submits that clearly such is **not** the case here, as the combined teachings

of the three cited references do **not** disclose, or even suggest, **all** of the limitations/features of each of the new claims 15-21.

More specifically, the claimed process relates to the production of "folding coupons" as increasingly employed by the cigarette industry as a supplement to cigarette packs. The folded coupons can be arranged within the cigarette pack, as well as outside the pack on a film wrapper or between the latter and the pack itself.

According to the knowledge on which the invention is based, the following characteristics are necessary for the design of a folding coupon as a supplement for cigarette packs that can be economically utilized by the cigarette industry:

a) The production of the coupons must conform to the high-performance output levels of modern packaging machinery for cigarettes. A "coupon maker" must therefore be capable of providing the required coupons to packs produced by an associated packaging machine on a 1 to 1 ratio. An objective of the invention is therefore to implement a high-performance production process of the coupons.

b) The coupons must be easy to handle to ensure that their positioning in or on the cigarette pack is technically practicable during the packaging process. This means that the coupons must be dimensioned with respect to the size of the cigarette packs and, above all, with respect to the pack surfaces available for the application of the coupons.

c) Despite its relatively small "basic surface area," the coupon should exhibit the largest possible "usable area," i.e., the largest possible printable surface area for accommodating advertising, product information, etc. on the coupon.

The process according to the invention as recited in claim 15, and also in dependent claim 16, fulfills these requirements. The production of the coupons can be assigned spatially and operatively to the packaging machine. High-output performance is given through the production of blanks as an intermediate product which are double the width of a coupon. A (center) severing cut results in the creation of two separate and complete coupons lying adjacent to one another. This makes it possible to feed each of the adjacently positioned coupons to a respective pack production path in the case of twin-path packaging operations. An important feature of the invention is that, after being severed from the material web, the double-width blank 15 is first folded in a folding assembly (of known design), after which the glue connections are activated. It is only then that the double-width blank is finally severed to form two folding coupons.

Particularly advantageous is the execution of the process pursuant to claims 16 and 17, corresponding to Fig. 8 to Fig. 11 of the drawings. By virtue of the special double-layer folding of the material web, folding coupons are created which have a plurality of folded layers (Fig. 11) without having to increase the number of folding steps in the folding subassembly ("buckle folder"). The twofold number of layers of the folding coupon pursuant to Fig. 11 is created by the pre-folding of the material web as shown in 8, Fig 9.

### **The prior art**

The aforementioned process is neither disclosed nor suggested by the combined teachings of the cited references.

1. U.S. 4,883,220 (**Brown**) does not relate to the immediate topic of the patent application, namely the production of coupons having multiple folds if necessary. Brown makes

proposals for the design of a mailable pre-shaped letter made from a foldable blank. The latter is severed from a continuous web. The blanks are provided with glue strips such that a closed letter can be folded (in a U-shape). The folding of the blanks, which can be severed from the material web in the transverse direction according to Fig. 1, is obviously carried out manually. At any rate, Brown provides no details as to how the non-folder blank, as shown in Fig. 2, is to be folded to form the envelope.

In terms of its production steps, it is also impossible to compare the technology presented in Brown with the process of new claim 15. In Brown, the blanks (Fig. 2) are severed from a continuous web (Fig. 1), whose width – except for the perforated strip along the margin – corresponds to the width of the blank. In contrast, the special feature of the patent application is that double-width blanks are produced, folded and completed with respect to the, adhesive bonding of folding legs. Only then are the blanks severed to form individual items for further processing. These steps are not evident in Brown.

2. U.S. 4,817,931 (**Vijuk**) is, in principle, closer to the subject matter of the patent application. Vijuk also relates to the production of folding coupons. To this end, individual, pre-fabricated blanks are directed through a folding assembly (buckle folder pursuant to Fig. 11, Fig. 12). In the region of this folding assembly the blanks are folded in two directions. Folding lines F1 and F2 run transverse to the longitudinal extent of the blank Fig. 2). Afterwards, transverse folding lines F3, F4 and F5 are applied, resulting finally in an extensively folded product pursuant to Fig. 8.

Compared to the claimed process, it can be seen that Vijuk first produces individual blanks 19 (Fig. 1A) which are then folded. Moreover, a folding process is executed in two Folding directions at right angles to each other. This does result in a favorable surface area distribution; however, the production of folding coupons with folds in two directions by means of two successive folding assemblies is **incapable** of achieving a high-performance output. The effort required for the production of a folding coupon pursuant to Fig. 8 is costly in terms of time and machine operation. Furthermore, it should be noted that each of the blanks (Fig. 2) produced are intended for a single coupon. Lacking here is the enhanced performance provided by double-width intermediate products (folded blanks 15).

3. In U.S. 4,812,195 (**Vijuk**) folding coupons are also produced (Fig. 4). Furthermore, they are made from a continuous web 28 by severing an elongate blank (Fig. 2) from the web and subjecting it to multiple folding operations along transverse folding lines 11b. The result is a multiple-folded blank or coupon having the width of the material web 28.

In comparison to the claimed invention, one can also see here that the performance of the Vijuk method is unsatisfactory. It fails to exploit the knowledge of: using a double-width as the starting; producing from it a double-width, folded intermediate product; and finally making the individual folding coupons merely by executing a severing cut.

4. A combined view of Brown and Vijuk also fails to lead to or otherwise render obvious the claimed invention. In **no** case is the use a double-width starting material proposed or even suggested for improved performance in the production of folding coupons.

In summary, then, and for reasons explained above, Applicant respectfully submits that the new claims 15-21 are neither anticipated (i.e., readable on), nor rendered *prima facie*, obvious by the three references cited in the first Office Action. Therefore, Applicant respectfully requests the Examiner reconsider and withdraw the rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102(b), and 35 U.S.C. § 103(a), and to find the application to be in condition for allowance with all of claims 15-21; however, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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